

## REMARKS

Claims 21-30 are pending in this patent application. Reconsideration of this patent application is respectfully requested.

### **35 U.S.C. § 103 Rejection (Matsen/Trail)**

Claims 21-30 were rejected under 35 U.S.C. § 103 as being unpatentable over Matsen, III (U.S. Patent No. 5,885,297) in view of Trail (EP 0 845 250). Reconsideration of claims 21-30 is respectfully requested.

### Discussion Re: Patentability of Claim 21

In an attempt to combine Matsen and Trail in a manner that arrives at the invention of claim 21, the following was stated in the 11/5/03 Office Action:

#### Page 3, Lines 2-5

It would have been obvious ... to modify the invention of Matsen, III to cut the greater tubercle when a replacement device such as Trail is to be implemented, for in order for proper fit would necessarily require removal of the greater tubercle.

However, Matsen states in its Summary of the Invention that "because [its] articular surface gauge is oriented to the orthopaedic axis and because it represents the desired prosthesis geometry, using it as a cutting guide *protects the rotator cuff ...*." (*Emphasis added*; See Matsen at column 2, line 66 through column 3, line 2.) Thus, it is clear that if Matsen's invention is designed to protect the rotator cuff, it would be contrary to Matsen's teachings to resect the greater tubercle since the insertion points for certain of the muscles which form the rotator cuff are located on the greater tubercle.

As a result, one skilled in the art would not have been motivated to modify the invention of Matsen to resect the greater tubercle when a replacement device is implemented. Indeed, one skilled in the art would be clinically motivated to leave the greater tubercle intact (including all the rotator cuff muscle insertions associated therewith), as Matsen itself acknowledges needs to be protected. If the examiner is somehow viewing Trail's device as inherently requiring resection of the greater tubercle to make room for part of its articular bearing surface, then a device such as Trail's would not be used, lest it damage an intact rotator cuff.

Furthermore, in cases where it may not be entirely inappropriate to implant a device such as Trail's into a humerus, e.g. in cases of extreme trauma in which the rotator cuff is no longer intact and in which the proximal humerus may be comminuted, Matsen discloses an entirely different approach which does not appear to include resection of a greater tubercle, nor even the use of a reamer. (See Matsen at column 9, line 16 through column 10, line 9.)

Thus, one skilled in the art would not have been motivated to combine Matsen and Trail in a manner that arrives at the invention of claim 21. Consequently, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established with regard to Applicant's invention of claim 21.

*Comment Re: Remarks in 11/5/04 Office Action at Page 3, lines 7-19*

Applicant's claimed invention recites many critical elements, including "resecting a greater tubercle," that collectively possess many inherent

advantages. Moreover, Applicant is not aware of any rule that limits the content of the specification only to the claimed invention. Substantial additional disclosure is allowed, and is typical included in patent applications filed in the U.S. Patent and Trademark Office.

#### Discussion Re: Patentability of Claims 22-25

Each of claims 22-25 depends directly or indirectly from claim 21. As a result, each of claims 22-25 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 21.

#### Discussion Re: Patentability of Claim 26

The discussion in regard to the patentability of claim 21 is relevant to the patentability of claim 26. As a result, claim 26 is allowable over the cited art.

#### Discussion Re: Patentability of Claims 27-30

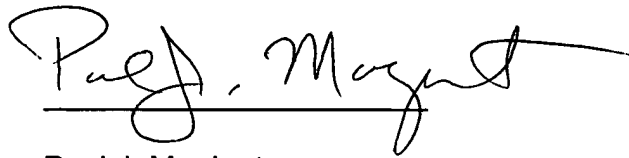
Each of claims 27-30 depends directly or indirectly from claim 26. As a result, each of claims 27-30 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 26.

## Conclusion

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

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A handwritten signature in black ink, reading "Paul J. Maginot", written over a horizontal line.

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